

REMARKS

Claims 19-50 and 54-60 have previously been canceled, without prejudice. Original claims 1-18 and 51-53 remain in the application.

Claims 1-18 and 51-53 have been provisionally rejected for obviousness-type double patenting over US Patent Application No. 09/679,039. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

Claims 1-18 and 51-53 are rejected for obviousness over US Patent No. 5,848,397 ("Marsh") in view of WO 99/59097 ("Werkhoven"). That rejection is respectfully traversed for the following reasons.

Claim 1, which is representative of the rejected claims, is directed to "software for use on a client device" that is configured for communications with at least one remote source of advertisements via a communications network. The software includes "an advertisement download function that downloads advertisements from the at least one remote source, during one or more advertisement download sessions", an advertisement storage function that stores the downloaded advertisements on a storage medium associated with the client device, and an advertisement display function that effects display of at least selected ones of the stored advertisements on a display associated with the client device. Claim 1 further includes:

"an obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement currently being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display; and

an obscured ad nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured ad nag display notifies the user of the obscured ad condition."

All of the functions recited in the rejected claims are functions of "software for use on a client device". Although they may interact or operate co-operatively with devices, computers, servers, other than the "client device", none of the claimed functions is part of, or for use on, any device other than the recited client device.

Marsh discloses message (ad) presentation functions that are distributed between a client computer and a server system. The complete disclosure of Marsh's system includes the subject matter of US Patent Application Serial No. 08/948,779 (now US Patent No. 6,014,502 of Moraes), incorporated by reference into Marsh at col. 2, lines 12-21. In Marsh's system, advertisements are selected by, obtained by, and downloaded from a mail server in a server system 104 that is "an electronic mail (e-mail) system which functions as an electronic post office." See Marsh at col. 6, lines 15-17. According to Moraes at col. 21, lines 3-6, the "banner and showcase advertisements are transmitted from the mail server M_n " when "the user connects to the mail server." According to Marsh at col. 16, lines 19-22, the advertisement download scheduler in the server system "controls the transfer of advertisements from a Mail server M_n to a client system 101." When Marsh's client system receives the downloaded ads, they are detected and stored by an advertisement display scheduler residing on a user computer. See Marsh at col. 3, lines 5-11. Thus, in Marsh/Moraes, advertisements are downloaded by a mail server to (not by) a client system in response to the client connecting to the mail server. The session in which advertisements are downloaded is an e-mail session, not an advertisement download session. Neither reference discloses or suggests that advertisements are transferred by "software for use on a client device" from at least one remote source "during one or more advertisement download sessions".

Claims 1-3, 6-8, 11-18, and 51-53

With respect to claims 1-3, 6-8, 11-18, and 51-53, the contention in the Office Action is that Marsh teaches software for use in a client device which includes an "an advertisement download function that downloads advertisements from the at least one remote source, during one or more advertisement download sessions (see figure 4, item 601)." But, item 601 of figure 4 is a banner advertisement displayed on an e-mail function screen. Figure 4 only teaches that an advertisement is displayed on a client device e-mail screen; it does not say how it got there. The only advertisement download function disclosed by Marsh resides in an "advertisement download scheduler" that "is located at the server system 104." As stated above, Marsh teaches that the "server system" includes the advertisement download scheduler which "determines when the advertisements are transferred to each user." According to Marsh at col. 16, lines 19-22, the advertisement download scheduler in the server system "controls the transfer of advertisements from a Mail server M_n to a client system 101." In contrast, the rejected claims explicitly recite that the "advertisement download function" is in "software for use

on a client device". Marsh does not disclose software for use on a client device with any function that "downloads advertisements".

Accordingly, Marsh omits "software for use in a client device" which includes "an advertisement download function that that downloads advertisements from the at least one remote source, during one or more advertisement download sessions."

The further contention is that "an obscured ad nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured ad nag display notifies the user of the obscured ad condition" is suggested by Werkhoven "because such a modification would allow to "determine if the user had closed the window containing the advertisement before the advertisement could complete its presentation" (col. 1, lines 28-30)." The applicants respectfully disagree.

The problem addressed by Werkhoven at page 1, lines 27-30 is a shortcoming of Internet advertising wherein "there is no way for *the advertiser* to determine if the user had closed the window containing the advertisement before the advertisement could complete its presentation." (Applicants' emphasis.) Werkhoven's solution to this problem is simply to record "whether the popup window was closed by the user prior to completion of" a "second interval." Werkhoven at page 2, lines 16-18. In contrast, the problem addressed by claim 1 is that of notifying a user (not an advertiser) of an obscured ad. The solution is to "nag the user to uncover the ad", not to record the fact. See the specification at page 29, lines 12-16. This solution is implemented in the obscured ad detection and nag functions that are explicitly recited in claim 1, and that limit all of the rejected claims.

Finally, the combination of Marsh with Werkhoven omits any function "that generates an obscured ad nag display." Instead, a blocked popup window is automatically repositioned to the foremost position without any display to notify the user of "an obscured ad condition."

With respect to claim 2, the obscured ad nag display "further notifies the user that the obscured ad nag display will be generated upon each future occurrence of an obscured ad condition." No such action is disclosed or suggested in either Marsh or Werkhoven.

With respect to claims 11-18, the remote source from which advertisements are downloaded includes "at least one ad server which stores at least one of a plurality of advertisements to be downloaded," and "at least one playlist server which stores at least one playlist each of which contains a list of the plurality of advertisements to be

downloaded, and the address of the ad server where each listed advertisement is stored.” As already stated, In Marsh, advertisements are downloaded from an e-mail server Mn; no other ad-serving or playlist-serving servers are disclosed. Werkhoven discloses “a computer user interface” which receives and displays push content from the Internet; however, Werkhoven does not describe the source of the content as anything other than a “world wide web page”. Neither Marsh nor Werkhoven teaches or suggests an “ad server” or a “playlist server”.

Claims 51-53 further limit the “software for use on a client device” to comprising “an installer function for installing the software.” Although both Marsh and Werkhoven describe user or client device software, neither describes “an installer function” as an element of “software for use on a client device.”

Accordingly, the combination of Marsh with Werkhoven fails to satisfy one or more requirements for *prima facie* obviousness and the rejection should be withdrawn with respect to claims 1-3, 6-8, 11-18, and 51-53. See MPEP 2142 et seq.

Claims 9 and 10

With respect to claims 9 and 10, Marsh at col.3, line 66 through col. 4, line 6 teaches “scheduling criteria” for advertisements which are selected with the goal of “maximizing advertising revenues to the e-mail service provider”. Claim 9, however, recites that “the software is subsidized by revenues attributable to the downloaded advertisements”. A subsidy is not revenue; it is a grant or a contribution of money. In other words software which is “subsidized” is free to someone (the user, for instance). The fact that Marsh’s e-mail provider receives revenues from ads does not lead to the conclusion that those revenues subsidize the client device software. In fact, Marsh and Werkhoven do not mention “subsidized” software at all. According to claim 10 the remote source includes “an advertisement distribution server system that is operated by a vendor of the software in order to distribute advertisements to clients of the vendor for the purpose of subsidizing the software.” Neither Marsh nor Werkhoven discloses “an advertisement distribution server system”. Marsh discloses only an e-mail server system; Werkhoven discloses only a WWW page. Further, neither reference discloses or suggests “subsidized software.”

Accordingly, the combination of Marsh with Werkhoven fails to satisfy one or more requirements for *prima facie* obviousness and the rejection should be withdrawn with respect to claims 9 and 10. See MPEP 2142 et seq.

Claims 4 and 5

With respect to claims 4 and 5, when an obscured advertisement is detected, the obscured ad nag function display notifies the user of three choices:

1. remove whatever is obscuring the obscured advertisement;
2. maintain the status quo, so that every future occurrence of an obscured ad condition will result in the generation of the obscured ad nag display; and
3. switch the operating mode of the software from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode.

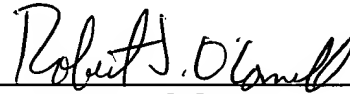
These are user choices, visibly displayed to the user, not alternatives implemented in machine logic without user notification. The contention is that Marsh and Werkhoven teach “giving the user a choice of opening a pop window in front of the advertisement displayed and notifying the user that” the advertisement is being obscured by removing whatever is obscuring the advertisement. However, Marsh does not detect obscured advertisements and therefore provides no notice of any course of action to rectify an obscured advertisement. Werkhoven detects a blocked popup window, but displays no choices to the user for rectifying the condition; in fact there is no choice according to Werkhoven. After a period of time, the popup window is “automatically” returned to a front position, and that action is taken by the computer, independent of the user’s volition. Because the popup window is “automatically returned”, there is no need to “display” choices for rectification in either Marsh or Werkhoven.

Official Notice is taken that “it is old and well known in the computer related arts to switch from one operating mode to another operating mode that has less features when a problem arises with one of the operating modes” in order to minimize problems that might otherwise occur. Perhaps this is so when software problems occur; however, it is as likely as not that the action is done “automatically” by the software, without any “choice” being given to the user of the software. Accordingly, the applicants respectfully request citation of a reference or entry of an affidavit to support this rejection. See MPEP 2144.03. Without such a citation, the combination of Marsh with Werkhoven fails to satisfy one or more requirements for *prima facie* obviousness and the rejection should be withdrawn with respect to claims 4 and 5. See MPEP 2142 et seq.

Therefore, in view of the failure of the art of record in this application to teach or suggest the entire invention recited in claims 1-18 and 51-53, it is submitted that these claims recite subject matter that is both novel and unobvious.

Respectfully submitted,

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